

REMARKS

The Office Action mailed September 30, 2004 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

Art Rejection(s) Under 35 U.S.C. § 102 and 103

Claims 1, 3 and 12 - 15 were rejected under 35 U.S.C. § 102(b) as anticipated by Aldous et al. (U.S. pat. no. 5,183,404). Claims 1 and 12 - 15, comprising all the independent claims, all recite a physical connection between the shell and the telephone (see for example Claim 1, "shell adapted to physically connect under a telephone"). This feature is not disclosed in Aldous, which describes the modem 10 as being "*near* a telephone base 12" (emphasis added), while illustrating it in FIG. 1 to be merely underneath the telephone. This is different from the claimed physical connection, which locks the components together to prevent theft or accidental dislodgement as the hotel occupant searches for the unfamiliar port to which to connect the computer.

It will be appreciated that, according to the M.P.E.P., a claim is anticipated under 35 U.S.C § 102(b) only if each and every claim element is found, either expressly or inherently described, in a single prior art reference¹. The aforementioned reasons clearly indicate the contrary, and withdrawal of the 35U.S.C. § 102(b) rejection based on Aldous is respectfully urged.

¹ Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)

Claims 2 and 4 – 6 were rejected under 35 U.S.C. § 103(a) as unpatenable over Aldous in view of “well known prior art.” No such prior art is produced in the Office Action, which relies on the bald assertion that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Aldous by specifically providing a wedge shaped modem, for the purpose of allowing the modem/telephone connection to be connected to a wall.” It is unclear how such a purpose is achieved by a wedge shape, and why a wedge shape is better suited for “allowing the modem/telephone connection to be connected to a wall” than other shapes. In any case, a primary motivation for providing the wedge shape in the present invention is to facilitate access to and visibility of the control pad and display of the telephone. The allegation of obviousness in the Office Action, without proper support or motivation, appears to be simply grounded in hindsight and *post facto* rationalization, neither of which is a permissible basis for a 35 U.S.C. § 103(a) rejection.

Moreover, the above obviousness rejection leaves the issue of physical connection unaddressed. As stated above, Aldous describes the modem 10 as being “near a telephone base 12,” while illustrating it in FIG. 1 to be merely underneath the telephone. There is no teaching or suggestion of physical connection to the telephone with its attendant advantages. For this reason as well, Applicants believe the obviousness rejection of claims 2 and 4 – 6 is improper and respectfully urge withdrawal of same.

Conclusion

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance. Such allowance is respectfully solicited.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

Please charge any additional required fee, including those necessary to obtain extensions of time to render timely the filing of the instant Reply, or credit any overpayment not otherwise paid or credited, to our deposit account No. 50-1698.

Respectfully submitted,
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